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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,707	06/11/2001	Patrick G. Ryan	19042/00101	3980
26116	7590	01/23/2006	EXAMINER	
SIDLEY AUSTIN LLP 717 NORTH HARWOOD SUITE 3400 DALLAS, TX 75201			GRAYSAY, TAMARA L	
			ART UNIT	PAPER NUMBER
			3636	

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,707

Applicant(s)

RYAN ET AL.

Examiner

Tamara L. Graysay

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-19 and 33 is/are allowed.
6) ☒ Claim(s) 20,21,24-26,28 and 30-32 is/are rejected.
7) ☒ Claim(s) 22,23,27 and 29 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 20, 21, 24-26, 28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Choudhury (article, Uses and consequences of electronic markets: an empirical investigation in the aircraft parts industry).

a. Claims 20 and 24: Choudhury teaches collecting inventory information (p. 473, col. 1, an electronic market to exchange information; fig. 2 inventory levels; p. 483, col. 1, purchases for inventory and aggregating expected consumption forecasts over the fleet) from a plurality of buyers (p.484, lines 3-17, communication among buyers (plural) and sellers (plural)); determining demand based on desired inventory profile and collected inventory information (p. 483, and col. 1); identifying an available supplier (p. 484, col. 1, lines 3-17, when a product (part) is requested the names of all sellers are listed); notifying at least a portion of the buyers (p. 484, col.1, lines 3-17, the requesting buyer is notified of product (part) availability) that have a current demand which corresponds to an available product supply (p. 484, col. 1, lines 3-17, a buyer requests a listing). The term marketing as used in the preamble is broad and has been interpreted to include notifying the buyer after a query is made about a particular product, or part as taught in Choudhury.

- b. Claim 21: Choudhury inherently includes periodic repetition of the steps insofar as Choudhury discloses a method used by various buyers and sellers when inventory or other constraints require that the buyer request products from a seller.
- c. Claim 24 (continued): Choudhury further discloses a method wherein the buyer requests information for a part (p.484, col. 1, lines 3-17) each time the buyer requests information, the method step of collecting information for each of a plurality of products from each of a plurality of buyers has been met.
- d. Claim 25: Choudhury discloses a method used by a plurality of buyers; therefore, the information collected is from a plurality of buyers for a plurality of parts (p. 484, col. 1, lines 3-17, communication among buyers and sellers).
- e. Claims 26 and 28: Choudhury discloses demand based on manual indication by the buyer (p. 484, col. 1, lines 3-17, the buyer requests listings of sellers for a part).
- f. Claim 30: Choudhury discloses the listing of surplus inventory on the inventory locator service (p. 483, col. 2, second paragraph). The term surplus is not defined in the specification. For purposes of this action, the claim has been interpreted broadly to include product in excess of demand.

g. Claim 31: Choudhury discloses a system for performing the steps of collecting, determining, identifying, and notifying, as discussed with regard to claim 20 above.

h. Claim 32: Choudhury discloses the system for facilitating marketing comprising a data input device (fig. 1, buyer 1-5), a calculating device (fig. 1, electronic market), a matching device (fig. 1, electronic market), and an output device (inherently disclosed, e.g., information requested by the buyer in a search for sellers would be displayed for the buyer's consideration).

Allowable Subject Matter

2. Claims 1-19 and 33 are allowed.

3. Claims 22, 23, 27 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 14 November 2005 have been fully considered but they are not persuasive.

Applicant argues that the claimed subject matter is limited to aggregating demand by collecting information from each of a plurality of buyers and determining product demand for each buyer, stating that the buyers are owners. More particularly, applicant argues the Choudhury reference does not aggregate demand over *multiple owners*.

In response, the examiner's position is that the terms buyer and seller are labels assigned to the particular entity in the supply chain process and nothing more. The claims at issue include both process (claims 21, 21, 24-26, 28, 30) and apparatus (claims 31 and 32).

The examiner's position with regard to a process claim is that the terms buyer and seller may narrow the scope of a process claim, but only as defined by the process steps, i.e., acts or activities, that are performed by the entities having the buyer and seller label. If there is no buying (or selling) activity, then the use of the term buyer (or seller) does not limit the claim scope and cannot limit the claim more than the recited steps. In other words, applicant is relying on limitations that are taken from the specification (what a buyer or seller is or does) in support of the argument. For example, applicant is arguing that Choudhury's multiple fleet members are not multiple *owners*. The examiner strongly disagrees and points out that the claims do not require any buying or selling. The claims are directed to demand analysis, which is met by Choudhury's plurality of fleet members. In terms of marketing and/or accounting, Choudhury's fleet members are separate entities that "demand" product and are "supplied" product. Therefore, the reference as applied in the above rejection meets the limitations as set forth in the process claims.

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The examiner's position with regard to an apparatus claim is that the terms are merely labels and no further limitation can be read into the claim from the specification. In particular, neither the role of a buyer nor the role of a seller can be included in the scope of the claim as written. Therefore, the reference as applied in the above rejection meets the limitations as set forth in the apparatus claims.

Conclusion


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on (571) 272-6856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay
Examiner
Art Unit 3636